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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/810,920	03/16/2001	Steven P. Bitler	12969-1	7133

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EXAMINER

SZEKELY, PETER A

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 05/08/2002

8

Please find below and/or attached an Office communication concerning this application or proceeding.

T.D-8

# Office Action Summary

Application No.

09/810,920

Applicant(s)

Bittler et al.

Examiner

Szekeley

Group/Art Unit

1714

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on 3/12/02
- ☒ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-7 and 9-46 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☒ Claim(s) 6, 7, 13-19, 26-31, 41, 42, 45 and 46 is/are allowed.
- ☒ Claim(s) 1-5, 9-12, 20-25, 32-40, 43 and 44 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
  - ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_
  - ☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

Office Action Summary

Art Unit: 1714

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-5, 9-12, 20, 37 and 38 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no mention in the specification a side chain crystalline polymer "being present in an amount such that it thickens the oil".

3. Claims 1-5, 9-12, 20, 37 and 38 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. There is nothing in the specification to guide one of ordinary skill in the art, to determine the level of concentration at which the polymer starts to thicken the oil.

4. Claims 21-25, 39 and 40 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The "at least 2% by weight" concentration level of the side

Art Unit: 1714

chain crystalline polymer cannot be found in the specification. 2-7%, 2-10% and 7-10% by weight are acceptable.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 32-36, 43 and 44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. The term "long chain acid" in claim 32 is a relative term which renders the claim indefinite. The term "long chain acid" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The length of the chain is not known.

8. The term "long chain alcohol" in claim 32 is a relative term which renders the claim indefinite. The term "long chain alcohol" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The length of the chain is not known.

9. The term "long chain alcohols" in claim 32 is a relative term which renders the claim indefinite. The term "long chain alcohols" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The length of the chain is not known.

Art Unit: 1714

10. The phrase "oily esters" is also indefinite in claim 32. Which esters are oily and which are not?

11. Applicants are warned that the deletion of the phrase "long chain" would make the claims broader than the specification.

***Claim Rejections - 35 USC § 102***

12. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

13. Claims 1-5, 9-12, 20, 37 and 38 are rejected under 35 U.S.C. 102(b) as being anticipated by Mueller et al. 5,281,329.

14. The contents of the reference have been discussed already in Paper #4. Since the minimum amount of side chain crystalline polymer necessary to thicken the oil is not known, the limitation is meaningless. Furthermore the limitation is new matter and not enabling. Also Mueller et al. do not use the SCC polymer as a thinner, but as a pour point depressant, i.e. a freezing point depressant. What happens to the viscosity when the SCC polymer is added in amount of less than 1% is not known. The only thing we know from applicants' specification is that they used it in a concentration of between 2 and 10% by weight. Since applicants are trying to cover the 1-2% range with their new limitation, the 2-10% range limitation is meaningless. The rejection is maintained.

Art Unit: 1714

***Claim Rejections - 35 USC § 103***

15. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

16. Claims 1-5, 9-12, 20, 32-38, 43 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mueller et al. 5,281,329.

17. Mueller et al. is useful with petroleum oil fractions. See column 3, line 60. Since mineral oils and vaseline oils are petroleum oil fractions, the use of the pour point depressant of Mueller et al., in applicants' claimed compositions, would have been clearly obvious to one with ordinary skill in the art, at the time the invention was made. Also, it would have been obvious to one having ordinary skill in the art, at the time the invention was made, to add the polymers of Mueller et al. to the oil of Mueller et al. without diluting them with a solvent, in order to avoid the necessary steps of dealing with environmentally harmful solvents. The rejection is maintained.

***Allowable Subject Matter***

18. Claims 6, 7, 13-19, 26-31, 41, 42, 45 and 46 are allowed.

***Conclusion***

19. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

Art Unit: 1714

MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Szekely whose telephone number is (703) 308-2460. The examiner can normally be reached on Tuesday through Friday from 7:00 a.m. to 5:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on (703) 306-2777. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-7718 or (703) 305-5408.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Peter Szekely

Primary Examiner

Art Unit 1714